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ART UNIT: 2451	<div style="border: 1px solid black; padding: 10px; text-align: center;">CERTIFICATE OF DEPOSIT DATE OF DEPOSIT: <u>February 26, 2010</u> I hereby certify that this paper or fee (along with any paper or fee referred to as being attached or enclosed) is being electronically deposited using EFS Web with the United States Patent Office on the date indicated above. _____ /SteveMPerry/ Steve M. Perry</div>
EXAMINER: Tran, Nghi V	
APPLICANT: Todd M. Goin	
SERIAL NO.: 10/701,869	
FILED: November 5, 2003	
CONF. NO.: 6726	
FOR: METHOD AND SYSTEM FOR ADJUSTING THE RELATIVE VALUE OF SYSTEM CONFIGURATION RECOMMENDATIONS	
DOCKET NO.: 200310588-1	

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REPLY BRIEF

Commissioner for Patents
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Mail Stop Appeal Brief – Patents

Sir:

Appellants submit this Reply Brief in response to the Examiner's Answer mailed January 7, 2010 in connection with their appeal from the final rejection of the Patent Office, mailed July 23, 2009, in the above-identified application. A Notice of Appeal was filed on October 1, 2009.

I. STATUS OF CLAIMS

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diao et al. (US 2005/0086645), hereinafter referred to as “Diao”, in view Carlson et al. (US 2003/0135609), hereinafter referred to as “Carlson”.

Claims 1-20 are appealed.

II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for review are:

A. Whether claims 1-20 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Diao in view of Carlson.

III. RESPONSE TO EXAMINER'S ANSWER

A. Rejection of claims 1 and 5

The Examiner begins a Response to Argument by stating that Appellant fails to consider the combination of references and instead attacks references individually. While it may be true that non-obviousness cannot be shown by attacking references individually, it is also true that to uphold an obviousness rejection, each individual part of a claim must be identified in one or more references. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Thus, the arguments presented by Appellant are not attempting to show non-obviousness by looking at the references in isolation from one another, but instead demonstrate that the individual parts of the claims have not been identified in one or more of the prior art references. Where the cited references fail to disclose one or more elements of the claim, the obviousness rejection cannot be upheld.

The Examiner has acknowledged that Diao fails to disclose assignment of a weight value. For an obviousness rejection to stand, the only other reference cited, Carlson, must disclose assignment of a weight value. Appellant asserts that Carlson does not disclose such a feature and that addressing the lack of such a feature in Carlson is a proper argument of non-obviousness, as has been asserted by the Examiner.

Carlson describes that a determination is made of values for service level parameters and whether service level parameter values satisfy predetermined service level thresholds. The use of thresholds in the system of Carlson is not the same as the assignment of weight values that represent a relative value of performance improvement based on implementation of computer configuration changes, as specifically recited in claim 1. For example, the setting of a first

threshold and a second threshold in Carlson does not affect any weighting values assigned to parameters to be compared against those first and second thresholds, and thus Carlson does not teach or suggest the assignment of weight values.

Not only does Carlson fail to disclose assignment of weight values, but Carlson fails to disclose assignment of weight values **representative of a relative value of performance improvement based on implementation of each of the computer configuration changes as compared to performance improvements from other configuration changes**, as claimed. At no point has the Examiner even attempted to address the claim language identified above in bold which describes the assignment of weight values. Carlson does not teach weight values representative of a **relative value of performance improvement based on** implementation of each of the computer **configuration changes as compared to** performance **improvements from other configuration changes**.

For the foregoing reasons, Appellant submits that the Examiner's assertions are in error and respectfully requests that the Appeals Board overturn the rejection.

B. Rejection of claims 1, 9 and 17

The Examiner begins a section II of the Response to Argument section by repeating that Appellant fails to consider the combination of references and instead attacks references individually. Appellant again asserts that if neither of the cited references disclose a feature of Appellant's claims, no combination of the references can overcome such a deficiency. Appellant directs the Examiner to the case law described, *supra*.

The Examiner asserts that Appellants arguments are not commensurate with the scope of the claim because the claims do not recite "the assignment of weight values that represent a

relative value of perform (*sic*) improvement based on implementation of computer configuration changes”. It appears that the Examiner has failed to read the claim accurately. For example, the language directly from claim 1 states that “assessing is made by assigning a weight value that represents a relative value of performance improvement based on implementation of each of the computer configuration changes”.

The Examiner asserts that assigning a weight value is nothing more than the service parameter setting in the GUI panel 800 of fig. 13 [of Carlson], see paragraph 0105. This setting of a parameter using a GUI is a value assigned by a user. The value is not a weight value. The value is not representative of a performance improvement. The value is not based on configuration changes. The value is not based on configuration changes compared to improvements from other configuration changes.

The Examiner asserts that Diao discloses a relative value of performance improvement based on implementation of each of the computer configuration changes and that combination of such a feature with Carlson renders obvious the elements of Appellant’s claims. First, Applicant notes that the service level parameters referred to by the Examiner in the Abstract of Carlson indicate “a state of the resources in the system”. Thus, the service level parameters are not weighting values. Considering the service level parameters as a state of resources in the system, the Examiner states that Diao discloses performance of system resources as poor or good, which is a state or system resources. Thus, the service level parameters (which are not weighting values) are taught by Diao and there is no motivation to combine the references. Furthermore, since Diao fails to disclose the weighting parameters, the combination fails to render obvious the claims of the current application.

The final language of the claim states that the relative value of improvement is based on implementation of each of the computer configuration changes as **compared to performance improvements from other configuration changes**. The Examiner states that Diao discloses a comparison to performance improvements from other configuration changes and cites Diao [0050]. However, throughout Diao it is unequivocally clear that performance is not measured against performance from other configuration changes. The cited paragraph of Diao reinforces this and states that the performance improvements are compared to goals set by an administrator. The goals are not described as being in any way tied to previous performance improvements from other configuration changes.

Therefore, Appellant submits that the claims are in condition for allowance and respectfully requests that the Appeals Board overturn the rejection.

C. Rejection of claims 2, 10 and 18

The Examiner's Response to Arguments states that because Carlson discloses an administrator obtaining information about configuration policy parameters for a selected policy that Carlson discloses receiving user input with respect to which ones of a plurality of collectors are to be utilized to obtain the performance metric for the computer system. Not only does the Examiner's argument fail to identify collectors for collecting performance metrics, but the argument fails to address selection among a plurality of collectors as to which collector will be used to obtain performance metrics. An administrator obtaining more configuration information is not the same as a user selecting which collector among multiple collectors should collect performance data. Furthermore, configuration information is not the same as performance metrics.

The Examiner states that Carlson discloses collectors which also run tests on various components of the network. Not only does Carlson fail to disclose collectors as claimed, as described above, the beta testing referring to in [0096] of Carlson is not performed by a collector or any part of the Carlson system. The beta testing is field data that is separately obtained and then made available. Thus, Carlson fails to disclose a system element which performs tests. Furthermore, the beta testing referred to in [0096] of Carlson is not related to or performed by any of the functions shown in FIG. 18 or paragraphs [0130-0135] recited by the Examiner.

Therefore, Appellant submits that the claims are in condition for allowance and respectfully requests that the Appeals Board overturn the rejection.

D. Rejection of claims 7 and 16

The Examiner asserts that Diao compares performance after a configuration change to performance baselines stored beforehand. As has been discussed above, and as is explicitly clear from the paragraphs cited by the Examiner, Diao does **not** compare performance to other stored performance baselines. Diao compares performance to user-set performance goals. Nothing in the citations of Diao teach or suggest otherwise.

Therefore, Appellant submits that the combination of Diao and Carlson fails to render obvious the elements of the claims. Appellant submits that the claims are in condition for allowance and respectfully requests that the Appeals Board overturn the rejection.

IV. CONCLUSION

Appellant respectfully submits that the claims on appeal are patentably distinct from the asserted prior art references. Particularly, none of the asserted references or combinations of references motivates, teaches, or suggests one of ordinary skill in the art within the meaning of 35 U.S.C. § 103 to arrive at the presently claimed invention. Appellants contend that Diao and/or Carlson individually or in combination fail to teach each and every element of the claimed invention.

For these reasons, Appellants respectfully request that the Board of Appeals reverse the rejection and remand the case to the Examiner for allowance.

Dated this 26th day of February, 2010:

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